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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,305	03/02/2005	Maikel Albert Walther Klomp	NL 020866	3587

24737 7590 12/23/2008
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

SHALLENBERGER, JULIE A

ART UNIT	PAPER NUMBER
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2885

MAIL DATE	DELIVERY MODE
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12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,305	Applicant(s) KLOMP ET AL.	
	Examiner JULIE A. SHALLENBERGER	Art Unit 2885	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendments submitted 10/20/08 have been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-13, 15, 16 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynne Willson (6,676,284) in view of Fermgard (2004/0179000).

In regard to claims 1, 10, and 18, Wynne Wilson teaches an LED assembly with a plurality of flexibly mounted (col. 6 line 45) LEDs suitable to form a string (col. 9 line 63) with an LED mounted with a mounting base 3, but lacks the teaching of the wires being protected from surroundings by a package of hot melt material.

Fermgard teaches a light emitting diode that is mounted and secured using a hot melt adhesive.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the light device of Wynne Wilson with the hot metal material mounting means taught by Fermgard in order to provide a strong bonding means with lasting durability to protect the diode by securing it in its intended place.

In regard to the wires being environmentally protected from exposure to the surroundings by a package of hot melt material, Willson modified by Fermgard is capable of meeting the claimed limitation.

In regard to the limitations of claims 2, 9, 19, and 21 which recite the hot melt material of the assembly provides for a protection whereby ingress of dust shall (or splashed water) not penetrate in a quantity to interfere with the satisfactory operation of the assembly or to impair safety by surrounding exposed portions of the electrical contact wires and a portion of the LED, it is noted that “configures to” and “capable of” are functional limitations and the applicant is advised that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

In regard to claims 3 and 11, Willson teaches a plurality of LEDs 15.

In regard to claims 4, 13, and 22 Wilson teaches electrical connection wires (see figures 2 and 3), a control system and a matrix arrangement with multiple LED assemblies (col. 11 lines 10-60).

In regard to claims 8 and 23, Willson teaches LEDs arranged in a matrix (col. 11 lines 47-53)

In regard to claim 12, Willson teaches different colored LEDs (col. 13 lines 20-29).

In regard to claims 6, 15, and 20 and Wynne Wilson teaches mount LEDs 5 to base 3 and since the LEDs are mounted on the front side of the base, there would be no need to provide hot melt on the back side of the base.

Art Unit: 2885

In regard to claims 7 and 16, Wilson does not specifically teach LEDs that are separated from each other by about the length of their contact wires. However, figure 9 shows LEDs that appear to be spaced apart about the distance of their contact wires.

Furthermore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to separate the LEDs by a length of the contact wire in order to position the LEDs as close as possible while leaving some distance so that heat generated from the LEDs does not damage or impede the life of the light source.

Claims 5, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynne Willson modified by Fermgard and further in view of Epstein (6,801,276).

Wynne Willson modified by Fermgard teach an invention including Wilson's teaching of an LED assembly suitable to form a string (col. 9 line 63), a matrix arrangement (col. 11 lines 10-60), and different colored LEDs (see abstract and claims) as recited in claim 17, but they lack the teaching of a diffusing means within the hot melt or different colored strings

Epstein teaches a hot melt adhesive with diffusing properties (col. 4 lines 17-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the light of Wynne Willson and the hot melt of Fermgard with the diffusing hot melt taught by Epstein in order to enhance the amount of light emitted by the diode. Furthermore, it would have been obvious to one of ordinary skill

Art Unit: 2885

in the art at the time the invention was made to make the diffusing material white in order to emit white light.

In regard to the different colored strings, Willson teaches different colored LEDs and a matrix arrangement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use different colored light strings in order to enhance the aesthetic appeal

Response to Arguments

Regarding the argument that “whether or not a combination of prior references is capable of fulfilling a stated claim recitation is not sufficient to render the claim limitation obvious in light of the prior art”, may be true for structural claims, however the claimed limitations in question are functional and merely require the ability to perform the function.

Furthermore, with regard to the argument the prior art references do not teach “ the LED mounting and electric contacts to the connection wires are environmentally protected”, it is noted that the prior art reference do not have to explicitly teach a functional recitation so long as the prior art references are capable of performing the function.

The applicant appears to be confusing intended use with functional language. While the two are similar, intended use recitations appear in the preamble and functional recitations appear in the body of the claim. The claims in question are functional because they recite a function (environmental protection) and the applicant

Art Unit: 2885

appears to be arguing that the function adds structure to the claim, however that is not the case.

With regard to functional language, the applicant is advised that it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138

With regard to intended use, please refer to *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

In response to the applicant's arguments that Fermgard does not teach hot melt adhesive that environmentally protects the LED wires, they are not persuasive since Fermgard teaches fixing an LED to a base 5 such that the “LED is fixed by means of hot melt adhesive”, the LED and its wires would have to be protected from damage caused by exposure with the environment since the LED is fixed with a hot melt material.

Fermgard may teach a mounting part 5, as well as a glass cover 26, providing protection, however these components do not negate the fact that the hot melt also provides protection for the LED and the LED's wires. Willson modified by Fermgard teaches the recited claim limitations.

In response to applicant's argument that references provide no suggestion to combine hot melt adhesive with LEDs, the applicant is advised that suggestion or motivation to modify a prior art structure can be found in a reference, or reasoned from common knowledge in the art, scientific principles, art recognized equivalents, or legal precedent. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Art Unit: 2885

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have recognized and appreciated the hot melt fixing means taught by Fermgard as capable of protecting the LEDs and contacts of Wayne Willson's device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie A. Shallenberger whose telephone number is (571)272-7131. The examiner can normally be reached on Monday - Friday 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on 571-272-7044. The fax phone

Art Unit: 2885

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAS
AU 2885
/Anabel M Ton/

Primary Examiner, Art Unit 2875